

AF/JRW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Joyce Fernandez
Ser. No. 10/683,616
Filed 10/14/03
For "Child Sling"

: Art Unit 3727
: Examiner Larson, Justin Matthew
:

8 Scenic Drive; Hagan Farms
Poughkeepsie, NY 12603-5521

May 24, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop - Petition

PETITION

Sir:

In partial response to the Office communications mailed 2/24/06, 3/31/06, and 4/26/06, applicant hereby petitions the Commissioner for Patents in the above-identified application (A) to set aside the action of 2/24/06 as FINAL; (B) to overrule the Examiner's refusal to enter, per the Advisory Action mailed 3/31/06, the amendments proposed in the Amendment After Final dated 3/18/06 and filed 3/22/06; and (C) to overrule the Examiner's refusal to enter, per the Advisory Action mailed 4/26/06, the amendments proposed in the Second Amendment After Final dated 4/5/06 and filed 4/7/06.

The Amendment After Final dated March 18, 2006 and filed March 22, 2006, stands not entered because the Examiner in the Advisory Action mailed 3/31/06 held that the proposed amendments "raise new issues that would require further consideration and/or search. The newly added limitations of 1.) 'the channel being formed by folding the length of the fabric and sewing in a line across the width of the fabric some inches from the fold' and 2.) 'the pocket beyond the knot is made up of the fabric itself by simply folding over an end of it and sewing the sides' were not previously presented".

Per the Second Amendment After Final dated 4/5/06 and filed 4/7/06, applicant changed the proposed Amendment After Final to eliminate the newly added limitations of 1) "the channel being formed by folding the length of the fabric and sewing in a line across the width of the fabric some inches from the fold" and 2) "the pocket beyond the knot is made up of the fabric itself by simply folding over an end of it and sewing the sides". Thus the limitations concerning a "channel" have been removed from claims 1, 7 and 15 (and hence from their dependent claims). The limitations concerning a "pocket" were removed from claims 5 and 6, and from claims 13 and 14 (and hence from their dependent claims).

The Amendment After Final dated 4/5/06 and filed 4/7/06, stands not entered because the Examiner in the Advisory Action mailed 4/26/06 held that the proposed amendments "raise new issues that would require further consideration and/or search. The limitation requiring that the elongated piece of fabric has 'a width throughout its length to cover completely a child's buttocks and support the child comfortably' was not present in the claims examined before the previously mailed non-final and final rejections, and is thus a new issue. Examiner regrets failing to include this limitation in the list of new issues set forth in the previous Advisory Action. Regarding Applicant's assertion that the Final rejection was premature, the rejections involving the Cordisco reference were necessitated by Applicant's amendments to the claims, specifically the structure of claims 7-14 requiring the child sling to be located on a user's back when in use, and the Final rejection was therefore proper. See MPEP 706.07(a)."'

Applicant urges:

- 1) that no issue of new matter is involved: all of the matter covered by the proposed claims has been present in the application since it was filed;
- 2) that no new search should be required, either. MPEP Section 707.07(g) ordains that "Piecemeal examination should be avoided as much as possible." Moreover, MPEP Section 904.02 specifies that "In the examination of an

application for patent, an examiner must conduct a thorough search of the prior art."; and that "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed.";

- 3) that the subject matter of the proposed amendments were disclosed features which might reasonably be expected to be claimed. Thus they should already have been searched for, and no new search should be required.
- 4) that there being no new subject matter, and no need for a new search, the amendments proposed should be entered.;"
- 5) that applicant is entitled to have the amendments proposed entered, to have the amended claims examined and found allowable since they distinguish patentably over the cited art, and to have the application allowed; and
- 6) that the Final Rejection should be withdrawn as no clear issue had been reached.

ARGUMENT

A. Making the action of 2/24/06 as FINAL was not correct, and should be set aside.

Making the action of 2/24/06 FINAL was premature. While it is true that the application was being twice rejected, it is also true that applicant was making an earnest effort to place the application in condition for allowance by amending the claims to distinguish over the cited art. Furthermore, a final rejection on second action can be premature when a clear issue has not been reached. *Ex parte Ulfstedt and Bengtsson*, 109 USPQ 458; P.O. Sup. Ex. (1956). A clear issue has not been reached when different references are relied upon in successive actions.

B. The refusal to enter the Amendment After Final dated 3/18/06 and filed 3/22/06 was not correct!

The Amendment After Final dated 3/18/06 and filed 3/22/06, stands not entered because the Examiner in the Advisory Action mailed 3/31/06 held that the proposed amendments "raise new issues that would require further consideration and/or search. The newly added limitations of 1.) 'the channel being formed by folding the length of the fabric and sewing in a line across the width of the fabric some inches from the fold' and 2.) 'the pocket beyond the knot is made up of the fabric itself by simply folding over an end of it and sewing the sides' were not previously presented".

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- 3) that the subject matter of the proposed amendments were disclosed features which might reasonably be expected to be claimed. Thus they should already have been searched for, and no new search should be required.
- 4) that there being no new subject matter, and no need for a new search, the amendments proposed should be entered.;

5) that applicant is entitled to have the amendments proposed entered, to have the amended claims examined and found allowable since they distinguish patentably over the cited art, and to have the application allowed."

Thus applicant believes that, if the Commissioner deems any of the claims not to be allowable in their present state, the Examiner should be instructed to enter the proffered amendments for them.

C. Per the Second Amendment After Final dated 4/5/06 and filed 4/7/06, applicant changed the proposed Amendment After Final to eliminate the newly added limitations of 1) "the channel being formed by folding the length of the fabric and sewing in a line across the width of the fabric some inches from the fold" and 2) "the pocket beyond the knot is made up of the fabric itself by simply folding over an end of it and sewing the sides".

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Applicant urges that she was entitled to entry of these amendments for the reasons mentioned under "B" above.

She also believes she is entitled to entry of the amendments in view of the limitation not being included in the "list of new issues" in the first Advisory Action. Applicant is endeavoring to operate a new business, and finds the piecemeal examination onerous. New businesses have a tough time surviving.

SUMMARY

The amendments proffered by the Amendment After Final should be ordered entered. Appellant also urges that at best the final rejection was premature. The actions of the Examiner should be reversed.

Respectfully submitted,


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CERTIFICATE OF MAILING - The undersigned certifies that this correspondence addressed to the Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop - Petition; has been deposited in the United States Postal System as first class mail with sufficient postage on May 24, 2006.

